



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/748,391

12/30/2003

Adam Yeh

M61.12-0568

7557

27366 7590 11/27/2007

WESTMAN CHAMPLIN (MICROSOFT CORPORATION)

SUITE 1400

900 SECOND AVENUE SOUTH

MINNEAPOLIS, MN 55402-3319

EXAMINER

FREJD, RUSSELL WARREN

ART UNIT

PAPER NUMBER

2128

MAIL DATE

DELIVERY MODE

11/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/748,391

Applicant(s)

YEH ET AL.

Examiner

Russell Frejd

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10-15 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10-15 and 17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8.10.07</u> | 6) <input type="checkbox"/> Other: _____ |

In re Application of: Yeh et al.

Examination of Application #10/748,391

1. Claims 1-6, 8, 10-15, and 17-26 are pending in the application. Claims 7, 9, and 16 are canceled. This communication is in response to the amendment received on 10-August-2007.

Specification Objections

2. The disclosure is objected to because the information in the first paragraph of the specification, see the Preliminary amendment, needs to be updated to reflect the current patent numbers of the listed applications.

Claim Rejections under 35 U.S.C. § 101

3. 35 U.S.C. 101 reads as follows:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.
- 3.1 Claims 1-6, 8, 10-15, and 17-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
- 3.2 The Examiner posits that "system" claims 1 and 15 of the present invention are computer executable software code, or a program per se, having software instructions that implement the system for supporting analytical processing of transactional business data. For at least this reason, the software instructions of the present invention do not meet the criteria for a statutory

In re Application of: Yeh et al.

process (MPEP Section 2106.01).

3.3 MPEP 2106 provides the following supporting rational for this reasoning:

****>**Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

In view of the aforementioned requirement, the Examiner respectfully contends that the claim language of claims 1 and 15 appear to disclose software modules that do not impart functionality to the computer hardware, the software modules including [claim 1] a model service system, an entity generator, and a navigation service; and [claim 15] a design system and a navigation service.

The Examiner respectfully notes that Applicant's remarks describe claims 1 and 15 as capable of receiving inputs and generating outputs, as proof that the claimed elements are a “system”. However, it is noted that Applicant did not specifically indicate the system to be comprised of hardware. The Examiner respectfully posits that software modules are capable of receiving inputs and generating outputs, and requests that Applicant indicate the specific passages of the disclosure which describe the model service system, the entity generator, the navigation service, and the design system as hardware.

In re Application of: Yeh et al.

Double Patenting Rejections

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.3218 may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4.1 Claims 15, and 17-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-35 and 36 of U.S. Patent Application No. 10/725,665. This is a provisional rejection because the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations and dependent elements of claims 15

In re Application of: Yeh et al.

and 17-26 of the present invention appear to be a subset of the claimed limitations and combined elements of claims 17-35 and 36 of application 10/725,665.

Allowed Claims

5. Claims 1-6, 8, 10-15 and 17-26 are deemed allowable over the prior art of record at this time, pending resolution of any rejections noted above, because the prior art does not specifically disclose the claimed system for supporting analytical processing of transactional business data by an application.

Response Guidelines

6. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

6.1 Any response to the Examiner in regard to this non-final action should be

directed to: Russell Frejd, telephone number (571) 272-3779, Monday-Friday from 0530 to 1400 ET, **or** the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279. Inquires of a general nature or relating to the status of this application should be directed to the TC2100 Group Receptionist (571) 272-2100.

mailed to: Commissioner of Patents and Trademarks
P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to: (571) 273-8300

Hand-delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

Date: 25-November-2007

/Russell Frejd/
Primary Examiner AU 2128

**RUSSELL FREJD
PRIMARY EXAMINER**